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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,623	03/28/2006	Fumito Nishida	DC5181 PCT1	5536
137 7590 05/14/2009 DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994			EXAMINER	
			FLETCHER III, WILLIAM P	
			ART UNIT	PAPER NUMBER
			1792	
			NOTIFICATION DATE	DELIVERY MODE
			05/14/2009	ELECTRONIC

# Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

	Application No.	Applicant(s)			
	10/573,623	NISHIDA ET AL.			
Office Action Summary	Examiner	Art Unit			
	William P. Fletcher III	1792			
The MAILING DATE of this communication a Period for Reply	ppears on the cover sheet with the o	correspondence address			
A SHORTENED STATUTORY PERIOD FOR REF WHICHEVER IS LONGER, FROM THE MAILING  - Extensions of time may be available under the provisions of 37 CFR after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory perions are reply within the set or extended period for reply will, by static Any reply received by the Office later than three months after the main earned patent term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMUNICATION 1.136(a). In no event, however, may a reply be tind will apply and will expire SIX (6) MONTHS from the cause the application to become ABANDONE	N. mely filed the mailing date of this communication. ED (35 U.S.C. § 133).			
Status					
Responsive to communication(s) filed on <u>25</u> This action is <b>FINAL</b> . 2b) ☐ The 3) ☐ Since this application is in condition for allow closed in accordance with the practice under	nis action is non-final. vance except for formal matters, pro				
Disposition of Claims					
4) ☐ Claim(s) 1,2 and 6-16 is/are pending in the a 4a) Of the above claim(s) is/are withdi 5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) 1,2 and 6-16 is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction and Application Papers	rawn from consideration.				
· · _					
9) The specification is objected to by the Examination The drawing(s) filed on is/are: a) and a specificant may not request that any objection to the Replacement drawing sheet(s) including the correct of the specific to by the specific to be specification.	ccepted or b) objected to by the ne drawing(s) be held in abeyance. Se ection is required if the drawing(s) is ob	e 37 CFR 1.85(a). ejected to. See 37 CFR 1.121(d).			
Priority under 35 U.S.C. § 119					
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No.</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>					
Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date	4)  Interview Summary Paper No(s)/Mail D 5)  Notice of Informal F 6)  Other:	ate			

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#### **DETAILED ACTION**

## Terminal Disclaimer

1. The terminal disclaimer filed on July 25, 2008, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 10/573,623 has been reviewed and is accepted. The terminal disclaimer has been recorded.

## Response to Arguments

- 2. The claim objections set forth in the prior Office action are withdrawn.
- 3. The obviousness-type double patenting rejections set forth in the prior Office action are withdrawn in view of the TD.
- 4. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Silicone rubber substrates are taught by both US '791 [0066, 0071] and US '474 [6:54] as noted in the prior Office action.

## Claim Rejections - 35 USC § 103

- 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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6. Claim 1, 2, and 6-16, are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,589,280 A in view of US 5,137,791 A or US 2003/0085474 A1.

A. These references are applied herein again as set forth in the prior Office action.

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- B. It is the Examiner's position that the CLTE of the substrate is a result-effective variable affecting the temperature ranges over which an electronic device produced according the process of the cited references can operate. As such, it would have been obvious to one skilled in the art to optimize this value by routine experimentation, absent evidence of criticality. See MPEP 2144.05.
- C. With respect to claims 7-12, insofar as the composition of the silicone rubber affects this property and other physical properties, it would have been obvious to one skilled in the art to select a desired, appropriate composition. Further, as noted in the prior Office action and not expressly traversed by Applicant, it is the Examiner's position that these are conventional silicone rubber compounds and would have been readily obvious to one skilled in the art as expedients for providing the silicone rubber.
- D. With respect to claims 13-14, as noted in the prior Office action, US '280 teaches a thickness of 30-2,000 nm [claim 16].
- E. With respect to claims 15-16, while the claimed thicknesses are not expressly taught, the thickness of the metal layer is a result-effective variable affecting the durability of the film, the weight of the overall multi-layer structure, ad well as production cost. As such, it would have been obvious to one skilled in

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the art to optimize this value by routine experimentation, absent evidence of criticality. See MPEP 2144.05.

#### Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Sunday, 5:00 AM - 12:00 PM and Monday through Friday, 5:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Phillip Fletcher III/ Primary Examiner, Art Unit 1792

May 11, 2009